

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of  
Trademark Registration No. 2,772,766  
For the Mark SAN DIMAS GUITARS THE  
CALIFORNIA GUITAR COMPANY  
Registration Date: October 7, 2003

JACKSON/CHARVEL MANUFACTURING,  
INC.,

Cancellation No. 92042614

Petitioner,

v.

PRINS, LLOYD A.,

Registrant

To: Box TTAB/No Fee  
United States Patent and Trademark Office  
Trademark Trial and Appeal Board  
Arlington, VA 22202-3513

**REGISTRANT'S RESPONSE TO PETITIONER'S MOTION and SUPPLIMENT  
TO COMPEL AND TO TEST SUFFICIENCY OF RESPONSES TO  
ADMISSIONS REQUESTS**

Registrant Lloyd A. Prins hereby responds in opposition to Petitioner's Motion to Compel and to Test Sufficiency of Responses to Admissions (the "Motion") and in opposition to Petitioner's Motion to Supplement Its Motion To Compel and Reset Dates.

**I. PETITIONER FAILED TO MAKE A GOOD FAITH EFFORT TO  
RESOLVE DISPUTED DISCOVERY REQUESTS.**

On December 29, 2004, Petitioner served Registrant with a Rule 37 "Failure to Disclose Information" letter via Federal Express Overnight Mail (please refer to Exhibit G of Petitioner's Motion to Compel). This fourteen-page letter was received at 10:40 a.m. Pacific Coast time on December 30, 2004 (Exhibit A).

At 12:15 p.m. this same day (December 30), an hour and a half after delivery, Salvador Karottki, attorney for Petitioner, telephoned Registrant to discuss the content of his Rule 37 letter. Registrant told Karottki that he [Registrant] had just received the letter and had not yet had time to review it. The telephone call ended with an agreement to discuss the letter fully after Registrant had time to review the letter in its entirety.

On December 31, 2004 Petitioner filed its Motion to Compel with the TTAB.

On January 6, 2005, Registrant conferenced by telephone with Petitioner's attorney Karottki regarding Petitioner's Rule 37 letter. Registrant requested of Petitioner an early February reply to the Rule 37 letter. Karottki acknowledged that this would be acceptable due to the likely suspension of these proceedings while the TTAB considered Registrant's earlier submitted Motion To Compel. Registrant immediately followed up this call with a letter to Karottki making the same request (see Exhibit B, Prins' 1/6/2005 letter to Karottki).

At the time of the January 6, 2005 conference call between Petitioner's attorney Karottki and Registrant, Registrant was not aware that Petitioner had filed a Motion To Compel. During that twenty-minute phone call, Karottki never disclosed that he had already filed a Motion to Compel the very day after delivery of his Rule 37 letter. And because Karottki had used non-priority U.S. mail to send Registrant a copy of Petitioner's Motion To Compel, Registrant had not yet received a copy. Registrant understood that both parties were working together to resolve this dispute.

The good faith effort put forth, as certified by Petitioner in its December 31, 2004 Motion To Compel, included a fourteen-page Rule 37 letter delivered on December 30,

2004 and a telephone call made later that same day. In that call, Petitioner, through its attorney, requested Registrant to reply to that letter within twenty-four hours:

*“Jackson/Charvel’s counsel requested Prins to respond later that day or on Friday, December 31”* (See Petitioner’s Motion To Compel, page 3 ¶ 1)

Petitioner and Registrant may disagree with the content of the December 30, 2004 telephone call, however the paper record shows that Registrant was working in good faith to resolve the dispute. In Registrant’s January 6, 2005 letter, Registrant made the following request:

*“Considering this, if it is acceptable to you, please allow me until early February to craft my response.”* (Exhibit B)

This request remains unanswered.

The TBMP § 523.03 provides that “ A motion to compel . . . must, in any event, be filed before the first testimony period opens”. Petitioner delayed serving its Rule 37 letter until 3 days before the commencement of the first testimony period. Because of this, Petitioner did not leave adequate time in which to work cooperatively with Registrant to find resolution. Petitioner would have the TTAB believe that it was the Registrant who was the obstacle to finding resolution, however documented facts show otherwise.

Pursuant to 37 CFR § 2.120 (e) and TBMP § 523.02, the moving party must make a good faith effort to resolve with the other party the issues presented in the motion and was unable to reach an agreement. As described above, Petitioner’s actions fall severely short of a good faith effort and the Petitioner’s “Motion” in its entirety should be denied.

**II. Registrant's response to Admissions Request 11 is sufficient.**

Petitioner claims that Registrant's response to Admissions Request No. 11 is in disagreement with Registrant's response to Petitioner's Interrogatory No. 23. Admission Request No. 11 is specific to a Jackson/Charvel San Dimas trademark as defined by 15 U.S.C. § 1127. Registrant acknowledged, in its response to Petitioner's Interrogatory No. 23 that Petitioner incorporated the term "San Dimas" onto a decal that was applied to a guitar in 2003 however Registrant did not admit that this application constituted use of a San Dimas trademark as defined by 15 U.S.C. § 1127. For this reason, Registrant appropriately responded with a denial to Petitioner's Admissions Request No. 11.

**III. Registrant's response to Admissions Request 35 is sufficient.**

Petitioner's Admissions Request No. 38 propounded Registrant to admit or deny a fact upon which Registrant has no knowledge (prior use of a Jackson/Charvel "San Dimas" trademark as defined by 15 U.S.C. § 1127). Registrant has on numerous occasions requested Petitioner to provide such an example or samples but none have been provided. For this reason, Registrant, pursuant to FRCP 36(a) and TBMP § 407.03(b) responded that he could neither admit nor deny Admissions Request No. 38.

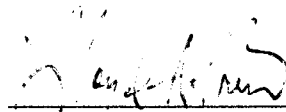
**IV. Registrant's Response to Petitioner's "Motion" is timely.**

In its January 21, 2005 Motion to Supplement its Motion To Compel, Petitioner pleads that the TTAB grant its December 31, 2004 Motion to Compel in its entirety due to Registrant's failure to respond within twenty days. Pursuant to 37 C.F.R. § 2.120(e)(2) and acting on the January 14, 2005 instructions from the TTAB, Registrant withheld a

reply to Petitioner's Motion To Compel because such a reply was not germane to the motion that was the source for the suspension. On February 10, 2005 Registrant contacted the TTAB for instructions on this matter and was told that such a response would be accepted, as the TTAB would be considering all of the motions during the suspension. Accordingly, Registrant's Responses to Petitioner's Motion To Compel And To Test Sufficiency Of Responses To Admissions Request and Motion To Supplement Its Motion To Compel And Reset Dates should be accepted as timely filed.

February 14, 2005

Respectfully submitted,



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Lloyd A. Prins  
Registrant  
San Dimas Guitar Company

## Exhibit A

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## Track Shipments Detailed Results

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<b>Tracking number</b>	791514251283	<b>Reference</b>	1719.117
<b>Signed for by</b>	Signature release on file	<b>Delivery location</b>	Glendale, CA
<b>Ship date</b>	Dec 29, 2004	<b>Delivered to</b>	Residence
<b>Delivery date</b>	Dec 30, 2004 10:40 AM	<b>Service type</b>	Priority Envelope
		<b>Weight</b>	0.5 lbs.

**Status** Delivered**You can also track:**

- [By TCN](#)
- [FedEx Tracking shipments](#)
- [By Email Tracking](#)
- [By FedEx V Solutions](#)

Date/Time	Activity	Location	Details
<b>Dec 30, 2004</b>	10:40 AM <b>Delivered</b>	Glendale, CA	No signature required - release waiver on file
	8:57 AM On FedEx vehicle for delivery	LOS ANGELES, CA	
	7:43 AM At local FedEx facility	LOS ANGELES, CA	
	6:09 AM At dest sort facility	BURBANK, CA	
	1:03 AM Departed FedEx location	MEMPHIS, TN	
<b>Dec 29, 2004</b>	9:28 PM Arrived at FedEx location	CHICAGO, IL	
	8:57 PM Left origin	CHICAGO, IL	
	6:17 PM Picked up	CHICAGO, IL	
	4:21 PM Package data transmitted to FedEx		

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## Exhibit B

Lloyd A. Prins  
San Dimas Guitar Company  
2323 Via Saldivar  
Glendale, CA 91208

January 6, 2005

Mr. Salvador K. Karottki  
Goldberg, Kohn  
55 East Monroe Street, Suite 3700  
Chicago, IL 60603

Re: Cancellation No. 92042614

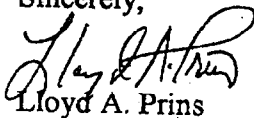
Dear Mr. Karottki,

This letter confirms my receipt of your December 29, 2004 Rule 37 letter. In it you ask that I respond to you immediately with additional information to your discovery requests. I am happy to reply, however the timing of your request coincides with my absolute busiest time of year as I work to prepare for the Winter NAMM Show scheduled for January 20-24, 2004.

I appreciate you taking the time to delineate the concerns you have with my responses to your first discovery requests. Your careful work warrants an equally careful and deliberate reply. Unfortunately my schedule simply does not allow me to do so. Considering this, if it is acceptable to you, please allow me until early February to craft my response.

Thank you for your time and consideration.

Sincerely,



Lloyd A. Prins  
San Dimas Guitar Company

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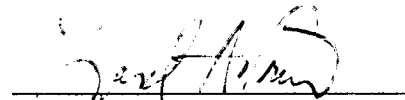
**REGISTRANT'S MOTION TO SUPPLEMENT IT MOTION TO COMPEL  
RESPONSES TO REGISTRANT'S FIRST SET OF INTERROGATORIES**

Registrant Lloyd A. Prins moves that its Motion To Compel Responses To Registrant's First Set of Interrogatories (the "Motion") be supplemented with the following statement:

I, Lloyd A. Prins, Registrant in the above captioned proceeding, certify that at the time of filing the Motion and continuing, have made every good faith effort by conference and correspondences with Petitioner and Petitioner's attorney to resolve the disputed issues presented in the Motion.

This supplemental statement is being provided pursuant to 37 C.F.R. § 2.120 (e) and TTAB § 523.02. Each good faith effort was clearly presented with supporting documentation with the original filing of the Motion.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "Lloyd A. Prins", is written over a horizontal line.

Lloyd A. Prins  
Registrant  
San Dimas Guitar Company

February 14, 2005

# **Certificate of Mailing and Notice of Service**

**Certificate of Mailing (37 C.F.R. 1.10)**

**TTAB**

I certify that a copies of:

REGISTRANT'S RESPONSE TO PETITIONER'S MOTION and SUPPLIMENT TO  
COMPEL AND TO TEST SUFFICIENCY OF RESPONSES TO ADMISSIONS REQUESTS;  
and

REGISTRANT'S MOTION TO SUPPLIMENT IT MOTION TO COMPEL RESPONSES TO  
REGISTRANT'S FIRST SET OF INTERROGATORIES

were mailed on February 14, 2005 via U.S. Postal Service, was deposited with sufficient postage  
and was addressed to:

Box TTAB No Fee  
United States Patent and Trademark Office  
2900 Crystal Drive  
Arlington, Virginia 22202-3513

## **Notice of Service**

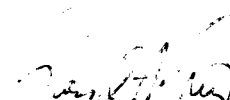
I also certify that a copy of:

REGISTRANT'S RESPONSE TO PETITIONER'S MOTION and SUPPLIMENT TO  
COMPEL AND TO TEST SUFFICIENCY OF RESPONSES TO ADMISSIONS REQUESTS;  
and

REGISTRANT'S MOTION TO SUPPLIMENT IT MOTION TO COMPEL RESPONSES TO  
REGISTRANT'S FIRST SET OF INTERROGATORIES

were mailed on February 14, 2005 via U.S. Postal Service, was deposited with sufficient postage  
and was addressed to:

Mr. Salvador K. Karottki  
Goldberg Kohn  
55 East Monroe Street  
Suite 3700  
Chicago, IL 60603-5802

  
Lloyd A. Prins      2/15/05  
Date



02-23-2005

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